

REMARKS

The present amendment is in response to the Office Action dated December 21, 2007, where the Examiner has rejected claims 1-24. In the present amendment, claims 1, 7-12 and 18 have been amended and claims 25-29 are new. Accordingly, claims 1-29 are pending in the present application with claims 1, 7, 12, 18, 25, 28 and 29 being the independent claims. Reconsideration and allowance of pending claims 1-29 in view of the amendments and the following remarks are respectfully requested.

A. Rejection of Claims 1-24 Under 35 USC § 103(a)

Claims 1, 2, 4-6, 18, and 21-24 stand rejected under section 103(a) as being unpatentable over GraFX Saver Pro,

<http://web.archive.org/web/20020823011437/www.cdhnow.com/ga.html> (CDH

Productions) in view of How To Write A 32-Bit Screen Saver

<http://www.wischik.com/scr/howtoscr.html> (Wischik). Claim 3 stands rejected under

section 103(a) as being unpatentable over CDH Productions in view of Wischik and in

further view of U.S. Patent No. 6,493,743 (Suzuki). Claims 7, 9, 12, 13, 15, and 16

stand rejected under section 103(a) as being unpatentable over CDH Productions in

view of Wischik and in further view of U.S. Patent No. 6,421,235 (Ditzik). Claim 8

stands rejected under section 103(a) as being unpatentable over CDH Productions in

view of Wischik and Ditzik and in further view of U.S. Patent Application Publication No.

2002/0055992 (King). Claim 10 stands rejected under section 103(a) as being

unpatentable over CDH Productions in view of Wischik and Ditzik and in further view of

U.S. Patent Application Publication No. 2003/0169306 (Makipaa). Claims 11 and 14

stand rejected under section 103(a) as being unpatentable over CDH Productions in

view of Wischik and Ditzik and in further view of U.S. Patent No. 6,810,115 (Fukuda).

Claim 17 stands rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and Ditzik in further view of King. Claims 19 and 20 stand rejected under section 103(a) as being unpatentable over CDH Productions in view of Wischik and in further view of King. The rejections are traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

In the Office Action, no motivation has been supplied for combining the references. With respect to the independent claims 1 and 18, the foregoing rejections all rely on CDH productions and Wischik. With respect to the independent claims 7 and 12, the foregoing rejections rely on the same references in addition to Ditzik for the disclosure of a wireless device.

While CDH and Wischik are both related to screen savers, their similarities stop there. Wischik is focused on how to write a screen saver program as reflected in the title "How to write a 32bit screen saver", while CDH describes a mere marketing pitch for a screen saver program to a potential user. As a result of their fundamental differences, the issues addressed unique to the references. For example Wischik addresses

software coding schemes, for example ConfigDialogProc, with detailed software language to provide or enable a skilled professional, for example a software programmer, to write the 32 bit screen saver. CDH on the other hand describes an off the shelf product to a consumer. In this case the off the shelf product happens to be a screen saver that requires the skill set of a common computer user for its use. Thus while Wischik is concerned with high level programming languages, CDH is concerned with the aesthetic or entertaining features, for example MP3, Audio, CD Audio etc., that are consumer friendly.

Further there is no motivation to combine Ditzik with either CDH or Wischik. Unlike CDH and Wischik, which deal with some form of software application, Ditzik is a small light weight modular microcomputer based on computer and communications systems. The elements or limitation of Ditzik are physical components while those of CDH or Wischik are software components.

Thus there is no motivation to combine CDH with Wischik or with Ditzik and since such a motivation or suggestion is required to establish a *prima facie* case of obviousness, the Office Action fails to meet its burden under section 103.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited references points to the reasonable expectation of success, which is the second requirement of the obviousness analysis. For example, even if CDH Productions could be combined with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda, it would still not result in directly transmitting the first ordered sequence associated with the first trigger event and the second ordered sequence associated with the second trigger event to a second user without a request from the second user.

For example CDH describes creating the professional screen saver on a computer with some specific minimum system requirements. Whether the program is loaded to the computer or downloaded from a website, the receipt of the screen saver program is in response to the request from a user. The other reference that deal with this issue also fails to address the issue of transmitting the first ordered sequence associated with the first trigger event and the second ordered sequence associated with the second trigger event to a second user without a request from the second user. While Suzuki publishes an application data to a network applicable type mobile terminal, the publication is also transferred at the request of the network applicable type mobile terminal. Therefore, the proposed combination of CDH Productions with Wischik, Suzuki, Ditzik, King, Makipaa, or Fukuda lacks some of the elements of claim 1 and therefore does not create a reasonable expectation of success.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims as amended. In view of the foregoing amendment, it is respectfully submitted that independent claim 1, for example, includes limitations that are not disclosed by the references. For example, independent claim 1 as amended recites in pertinent part:

arranging the plurality of media objects into a second ordered sequence responsive to the configuration instructions on the handheld wireless communication device;

associating the second ordered sequence of media objects with a second trigger event on the handheld wireless communication device;

directly transmitting the first ordered sequence associated with the first trigger event and the second ordered sequence associated with the second trigger event from the first handheld

wireless device to a second user of a second handheld wireless communication device without a request from the second user.

The applicant asserts that the references fail to teach "directly transmitting the first ordered sequence associated with the first trigger event and the second ordered sequence associated with the second trigger event from the first handheld wireless device to a second user of a second handheld wireless communication device without a request from the second user" The following argument applies to each of the remaining independent claims 7, 12, and 18 which include similar limitations as claim 1, although the actual wording varies.

The examiner correctly states that neither CDH nor Wischik disclose publishing a media package to a remote user device. However the examiner suggests that Suzuki discloses publishing media packages to a remote user device and that the screen saver is disclosed as one of the published packages. First, the primary references CDH and Wischik both fail to disclose the limitations of claim 1. For example, CDH and Wischik fail to describe "arranging the plurality of media objects into a second ordered sequence responsive to the configuration instructions on the handheld wireless communication device." CDH describes screen saver program for creating professional screen savers on a personal computer. In fact CDH specifies system requirements, for example windows 95/98/NT/2000/ME/XP, that are consistent with a personal computer or the like. Likewise Wischik describes how to write a 32 bit screen saver for Windows NT or Windows 95 that are both configured for a personal computer. Here the screen saver program is developed and used in a Windows NT and/or a Windows 95 environment and will be incompatible for use in a handheld wireless communication device.

Second, Suzuki fails to describe the limitations of claim 1 as amended. For example, claim 1 as amended describes "directly transmitting the first ordered sequence associated with the first trigger event and the second ordered sequence associated with the second trigger event from the first handheld wireless device to a second user of a second handheld wireless communication device without a request from the second user." Although Suzuki describes that the host PC extracts the entire application program files stored in the host PC and transfers to PDA1 (a network applicable type mobile terminal), the host PC transfers the application program files in response to a command from the PDA1. (Column 7, lines 44-54 and Column 1, lines 60-65). Thus the host PC does not operate or transmit independently of PDA1. In addition Suzuki describes transferring the application program files from a host personal computer to PDA1, a function that is inconsistent with the limitations of claim 1. Accordingly Suzuki fails to describe "directly transmitting the first ordered sequence associated with the first trigger event and the second ordered sequence associated with the second trigger event from the first handheld wireless device to a second user of a second handheld wireless communication device without a request from the second user."

Since Ditzik, King, Fukuda and Makipaa fail to cure the defects of CDH, Wischik and Suzuki, the combination of the references this aspect of the claims.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial

evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the cited references of record.

B. New Claims 25-29

Claims 25-29 are new claims with claims 25, 28 and 29 been the independent claims. The Applicant asserts that the claims are supported in the specification and that no new matter has been added. See for example, page 9 - second full paragraph, page 10 - first paragraph, page 11 - first paragraph, page 12 - first paragraph, page 14 - first paragraph and page 27 - second paragraph. The applicant asserts that the references fail to teach the limitations of claim 25. For example, independent claim 25 recites in pertinent part:

providing a plurality of media objects in a memory on the wireless communication device, wherein said media objects comprise at least audio files, image files, and transitions;

receiving via an input means on the wireless communication device configuration instructions from a user, the configuration instructions comprising selecting and ordering a subset of said plurality of media objects and specifying zero or more transitions between one or more pairs of adjacent media objects in the ordered subset of media objects;

arranging the ordered subset of different media objects and zero or more transitions into an ordered sequence responsive to the configuration instructions;

generating a media package comprising the ordered sequence of the subset of media objects and zero or more transitions, said media package capable of being executed by the processor on the wireless communication device;

storing the media package in the memory on the wireless communication device;

associating the media package with a trigger event;

storing the association of the media package with the trigger event in an association list in the memory on the wireless communication device, wherein the association list includes a plurality of media package and trigger event associations;

monitoring for the trigger event;
detecting the trigger event;
executing the media package by the processor on the wireless communication device to play, responsive to the trigger event, the media package; and
providing the media objects to the user via the at least two output devices on the wireless communication device.

The primary references CDH and Wischik both fail to disclose the limitations of claim 28. CDH describes screen saver program for creating professional screen savers on a personal computer. In fact CDH specifies system requirements, for example windows 95/98/NT/2000/ME/XP, that are consistent with a personal computer or the like. Likewise Wischik describes how to write a 32 bit screen saver for Windows NT or Windows 95 that are both configured for a personal computer. Here the screen saver program is developed and used in a Windows NT and/or a Windows 95 environment and will be incompatible for use in a handheld wireless communication device. The addition of Makipaa fails to cure the defect of both CDH and Wischik because Makipaa only describes a pre-configured downloadable screen saver. Nothing in Makipaa suggest or describes "providing a plurality of different media objects in a memory on the wireless communication device, wherein said media objects comprise at least audio files, image files, and transitions" or "receiving via an input means on the wireless communication device configuration instructions from a user, the configuration instructions comprising selecting and ordering a subset of said plurality of media objects and specifying zero or more transitions between one or more pairs of adjacent media objects in the ordered subset of media objects" or "arranging the ordered subset of media objects and zero or more transitions into an ordered sequence responsive to the configuration instructions" or "storing the association of the media package with the trigger event in an association list in the memory on the wireless communication device,

wherein the association list includes a plurality of media package and trigger event associations.” Makipaa simply receives the screen saver program and stores the screen saver program in a storage medium. (Abstract). When in the screen saver mode in Makipaa, the received screen saver allows different applications on the device to simply operate with reduced functionality compared with the full application mode of the application. (Page 2, paragraph 26). Thus the screen saver program in Makipaa includes a program that in operation manages the execution of applications in their screen saver mode. Simply suggesting that the limitations of Wischik and CDH can be combined with that of Makipaa is inconceivable because the screen saver application in both CDH and Wischik are incompatible with a screen saver program for a wireless handheld device, for example, described in Makipaa. King on the other hand simply describes displaying a picture file at a cellular telephone. (Abstract). While the picture files can be displayed as a screensaver, King fails to teach, for example, “providing a plurality of different media objects in a memory on the wireless communication device, wherein said media objects comprise at least audio files, image files, and transitions” or “arranging the ordered subset of different media objects and zero or more transitions into an ordered sequence responsive to the configuration instructions.” It can also be inconceivable to combine Wischik and CDH with King as the Windows NT/95 elements of Wischik and CDH are incompatible with the cellular phone described in King. Combining King with Makipaa also fails to teach the limitations of claim 28. The addition of Suzuki and Ditzik fail to cure the defects of the references discussed above. Accordingly the references individually or in combination fail to describe the limitations of claim 25.

The applicant asserts that the references fail to teach the limitations of claim 28 for similar reasons illustrated in the 103 rejection and the defects described in reference

to claim 28. In addition the references fail to describe “associating the media presentation with a trigger event on the first handheld wireless communication device,” “detecting the trigger event on the first handheld wireless communication device” and “playing the media presentation on the second handheld wireless communication device in response to the trigger event detected on the first handheld wireless communication device.” At best the closest reference describes receiving at a first device a screen saver application from a personal computer or server, and using the screen saver application in a way that is not in response to the actions on the first computer. Thus the screen saver received at the first device operates only in response to the actions on the first device. Thus the references fail to describe the limitations of claim 28. Further claim 29 adds the limitation of “storing the media presentation associated with the at least one trigger event in a storage medium coupled to the first handheld wireless device,” “generating a link to a list on the first handheld wireless communication device to each of the different media objects of the media presentation stored in the storage medium” and publishing the link to a second handheld wireless communication device. This additional limitation is also absent in the references provided. Thus claim 29 is also patently distinct from the references provided.

C. Conclusion

For all the foregoing reasons, an early allowance of claims 1-24 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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